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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,424	07/02/2003	Burns Phillips	50243-0001	5198

7590 08/23/2005
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EXAMINER

COMSTOCK, DAVID C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,424

Applicant(s)

PHILLIPS ET AL.

Examiner

David Comstock

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, "the middle arm" lacks antecedent basis and renders the claim unclear. For examination purposes, and as best understood, claim 8 will be considered as reciting a third segment of one arm being laterally displaceable relative to a first segment of another arm.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 12 and 17-20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor 5,976,171).

Taylor discloses a retractor 310 comprising a laterally extending rack and first and second arms (see Figs. 13B and 16). For simplicity, reference will be made to only

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one of the arms, since both are the same. However, it is recognized that only one of the arms has a housing 332 slidably engaging the rack 312 and including an adjustment mechanism 324,326. The arms have a first segment, 330A,330B, a second segment, 360, and a third segment, 338. The segments are hinged together at 331 and 363. The middle segment of both arms is angled toward the other arm by virtue of the outwardly angled portion of the "Y" shape forming the middle segment (see Fig. 13B). A facet of this outwardly angled portion is visible on middle segment 362, and reference numeral 360 points directly at the opposite angled facet. The angles between the first and middle segments on each arm and between the middle and third segments on each arm are equal, as both segments are identical. The first segments of the arms are parallel both at their base (the base of the "Y", i.e. 364) and at portion 368A,368B (again referring only to one of the arms). The third segments are parallel to each other at least along a portion thereof. The third segment is capable of being laterally displaced toward the first arm relative to the first segment thereof, at least by movement of the arms along the rack. The same device 310 alternatively includes rotation means 30 for allowing the arms to rotate about a longitudinal axis, e.g. A2, (see Fig. 16 and col. 13, lines 4-17). Both arms are rotatable. It is also noted that when the first segment of an arm rotates, so does the middle segment and the third segment at the end of the arm. Thus, when the first segments are rotated toward or away from each other, the third segments are capable of being displaced laterally relative to the first segments toward each other respective arm. Rotation means 30 is operable to lock the middle segment at a desired angular orientation about axis A2 (id.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (5,976,171) in view of Farley (4,989,587).

Taylor discloses the claimed invention except for providing both arms with a slidable housing and an adjustment mechanism. Farley discloses a retractor 19, wherein both arms 31 and 33 are provided with a slidable housing with an adjustment mechanism in order to facilitate independent movement and placement of the arms and allow a safer and more effective procedure (see Fig. 2; col. 1, lines 14-18; col. 4, lines 59-66; and col. 5, lines 16-19 and 33-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor of Taylor with both arms having a slidable housing and an adjustment mechanism, in view of Farley, in order to facilitate independent movement and placement of the arms and allow a safer and more effective procedure.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (5,976,171).

Taylor discloses the claimed invention except for the locking means being a lever. However, levers and threaded clamps are prevalent and equivalent structures for applying a clamping force to an object, known in the art. Because these two locking

means were known functional equivalents at the time of the invention, a person of ordinary skill in the art would have found it obvious to substitute a lever for a threaded clamp to apply clamping force.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (5,976,171) in view of Wright et al. (5,772,583).

Taylor discloses the claimed invention except for the rack having a domed shape. Wright et al. disclose a retractor 100 having a rack 110 provided with a dome shape to safely provide a natural surgical opening while not obstructing the surgeon's view of the work area (see Figs. 1-3; col. 1, line 16; col. 2, lines 12-18; and col. 3, lines 19-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor of Taylor with a dome shape, in view of Wright et al., in order to safely provide a natural surgical opening while not obstructing the surgeon's view of the work area.

Response to Arguments

Applicant's arguments filed 21 March 2005, have been fully considered but are not persuasive.

In response to Applicants argument that Taylor does not anticipate the invention as presently amended, it is noted that Applicant's amendment does amount to a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Here, the device is capable of performing the intended use, i.e. laterally displacing the third segment relative to the first segment toward each other arm, respectively, since the device includes rotation means 30 for allowing the first segment of the arms to rotate about a longitudinal axis, e.g. A2, as set forth in the rejection (see Fig. 16 and col. 13, lines 4-17). Thus, when the first portions are rotated, even slightly, for example, toward each other (or away from each other), then the third segment is capable of being displaced relative to the first segment, with at least a component of the displacement being in a direction toward each other respective arm. The disclosed structure is capable of performing the claimed intended use.

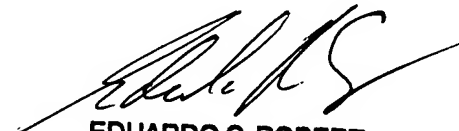
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
21 August 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER